

REMARKS

Claims **1 - 112** are pending in the present application.

Claims **1 - 9, 50, 52 - 59, 70 - 74, 77 and 101** are pending.

Claims **1, 50, 57, 70, 77 and 101** are independent.

RCE

A Request for Continued Examination has been filed.

Section 101 Rejections

Claims **1 - 9, 50 - 59 and 70 - 74, 77 and 101** stand rejected as being non-statutory for not "involving the technological arts".

We reiterate the arguments presented in the response to the Office Action mailed March 11, 2003. In summary, an improper legal standard has been used in the rejection.

The rejection refers only to claim **1**. Nevertheless, the rejection is purported to be a rejection of all claims as nonstatutory.

Further, although the basis of the rejection appears to be that a claim is not statutory if "all recited steps can be performed in the mind of the user", independent claims **77 and 101** are clearly system claims which require a memory, a communication port, and a processor connected to the memory and the communication port. It is not clear how the Examiner interprets these two independent claims as being performable "in the mind of the user". No reasoning appears describing the basis for the rejection of claims other than method claim **1**, much less system claims **77 and 101**.

Nevertheless, in order to expedite prosecution and issuance, independent claims **1, 50, 57, 70** have been amended to recite that all steps are not solely performed "in the mind of the user".

Section 102 and 103 Rejections

Claims **1 - 4, 6 - 7, 9, 50 - 59 and 70 - 74** are rejected as anticipated by Glickman.

Claims **1 - 4, 6 - 7, 9, 50, 56 - 59, 70 - 74, 77 and 101** are rejected as anticipated by Katz.

Various dependent claims are rejected based on combinations of Glickman or Katz in view of other references.

As explained previously, the claims (before amendment) distinguish over the references cited by the Examiner.

The Examiner's Interpretation of Glickman is Incorrect

Each of independent claims **1, 50, 57, 70, 77 and 101** were previously amended to facilitate prosecution and issuance of the present application. Each of the independent claims (both before and after the amendments presented by the current Amendment) generally includes a limitation involving

scoring / selecting / identifying a supplemental product based on profit / profitability of the supplemental product

The rejection of independent claims **50 and 57** erroneously ignored this feature of the claims.

In response to Applicants' amendment, the latest Office Action includes conclusory statements (without explanation) that Glickman "inherently" teaches scoring / selecting based on profit of the at least one supplemental product in the pool. Office Action, pages 4, 11, 16. However, there is no such suggestion, much

less inherency, in Glickman that profit or profitability is considered in scoring a supplemental product, selecting a supplemental product or identifying a supplemental product.

Inherency requires that extrinsic evidence makes it clear that (a) the missing descriptive matter is necessarily present in the reference, and that (b) it would be so recognized by persons of ordinary skill. In re Robertson, 169 F.3d 743, 49 USPQ2d 1949 (Fed. Cir. 1999). Probabilities or possibilities do not establish inherency. The mere fact that a certain thing may result from a given set of circumstances is not sufficient to show inherency. Scaltech Inc. v. Retec / Tetra LLC, 178 F.3d 1378, 1384, 51 U.S.P.Q.2D 1055 (Fed. Cir. 1999).

The Examiner has not provided any reasoning or evidence why Glickman inherently informs one of ordinary skill in the art that profit or profitability is considered in scoring a supplemental product, selecting a supplemental product or identifying a supplemental product.

Moreover, according to Glickman a variety of factors are considered to affect the number of people accepting the upsell, such as the "order of upsells" and the "price of upsells compared to the front-end offer". Profit is not suggested by any of these factors in Glickman.

Further Limitations Are Now Recited in All Claims

The Examiner has failed to present a *prima facie* case of unpatentability of any claim before amendment. Nevertheless, to expedite prosecution and issuance of the present application, all independent claims now recite further limitations which are not suggested by the evidence of record.

Representative limitations of various claims (none of which the prior art suggests) are listed below:

Independent Claims 1 and 77

*determining an offer amount for said supplemental product,
wherein said offer amount is based, at least in part, on an amount of
change due
providing an indication of the offer amount*

Independent Claim 50

*determining an offer amount for said supplemental product,
wherein said offer amount is based, at least in part, on at least one of
an amount of change due or a round-up amount
receiving an indication of an acceptance to purchase said supplemental
product at said offer amount*

Independent Claim 57

*determining an offer amount for said supplemental product,
wherein said offer amount is based, at least in part, on an amount of
change due
identifying, via a processor, a supplemental product based at least in part
on profitability of said product
providing an indication of an offer to sell said supplemental product at the
offer amount*

Independent Claims 70 and 101

*determining an offer amount for said supplemental product,
wherein said offer amount is based, at least in part, on an amount of
change due
providing an indication of an offer to sell said supplemental product at the
offer amount*

No Motivation to Combine

In addition, the obviousness rejections fail to set forth a motivation to combine or modify references, as is required under Graham v. John Deere Co., 383 U.S. 1, 86 S.Ct. 684, 15 L.Ed.2d 545, 148 U.S.P.Q. 459 (1966). That case places the "burden of proof on the Patent Office which requires it to produce the factual basis for its rejection of an application under sections 102 and 103". In re Warner, 379 F.2d 1011, 1016, 154 U.S.P.Q. 173, 177 (C.C.P.A. 1967).

For example, page 27 of the Office Action provides a purported motivation to combine Glickman, Katz and Myhre or Fiorini:

"it would have been obvious to one of ordinary skill in the art at the time of the invention to have based an offer amount at least in part on the amount of change due or a round-up amount in the method of Glickman or Katz as taught by Mylzre [sic] or Fiomi [sic] because change due or a round-up amount can be more costly than incorporating them into the offer amount as suggested by Fiomi [sic], and by basing the offer amount of the change due, you can impact upon inventory levels ms [sic] suggested in Myhre and do away with extra inventory"

As best as Applicants can interpret this statement, it appears to be an allegation that the combination of references would have been advantageous.

However, this is not a basis for a finding of obviousness. The prior art must suggest the desirability of the claimed invention. MPEP 2143.01. Obviousness can only be established where there is some teaching, suggestion, or motivation to do so found in the prior art. MPEP 2143.01. Here, the references provide no indication why one would modify either Glickman or Katz to incorporate anything involving "change" or "change due". Fiorini, for example, merely discusses the aversion to change, not how to profit from that aversion. The Myhre document is not prior art to the present application.

"Recognition of a need does not render obvious the achievement that meets that need. There is an important distinction between the general motivation to cure an uncured disease (for example, the disease of multiple forms of heart irregularity), and the motivation to create a particular cure."

Cardiac Pacemakers, Inc. v. St. Jude Medical, Inc., 381 F.3d 1371, 72 USPQ2d 1333, 1337 (Fed. Cir. 2004).

As another example, page 28 of the Office Action provides a purported motivation to combine Glickman, Katz and Lerner or Mold:

"the examiner notes that it is well known in the art to divide products into product groups, sub-groups, etc. or whatever you want to label the divisions for a plethora of purposes, including databases storage/querying/retrieval, filtering, identification, ease of use of the system/method for a merchant/consumer, etc. and that this has been done by in the retail environment for a long period of time. Examples of this include the fast food (menus, sandwiches, beverages, etc.), grocery (dairy, cheeses, frozen foods, meals, desserts) and department store models (clothing, men's, women's, children's, home furnishings, linens, china). Thus, it would have been obvious to one of ordinary skill in the art to have included product groups in the indicating step of Glickman and/or Katz as taught by Lerner or as well known in the art for the reasons set forth in Lerner or to optimize the identification step and facilitate the use of the system."

Regarding the assertions of what was well known, there is no evidence in the record to support these sweeping assertions. Accordingly, the conclusions which result from these assertions cannot be *prima facie* conclusions of obviousness.

In addition, the purported motivations "for the reasons set forth in Lerner" or "to optimize the identification step and facilitate the use of the system" would not prompt the proposed combination. On the contrary, the proposed motivation has little to do with anything taught by either Glickman or Katz. Further, the references do not show any desire "to optimize the identification step" nor any desire to "facilitate the use of the system" as asserted by the Examiner.

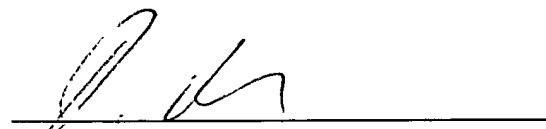
Accordingly, neither Lerner nor a desire "to optimize the identification step" nor a desire to "facilitate the use of the system" would prompt the proposed combination.

Conclusion

For the foregoing reasons it is submitted that all of the claims are now in condition for allowance and the Examiner's early re-examination and reconsideration are respectfully requested.

Alternatively, if there remains any question regarding the present application or any of the cited references, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact Dean Alderucci at telephone number 203-461-7337 or via electronic mail at Alderucci@WalkerDigital.com.

Respectfully submitted,



Dean Alderucci
Attorney for Applicants
Registration No. 40,484
Alderucci@WalkerDigital.com
203-461-7337 / voice
203-461-7300 / fax

November 11, 2004